

Remarks

Restriction Under 35 U.S.C. § 121

Claims 1-33 were divided into four allegedly distinct groups: Group I (claims 1-22), Group II (claims 23-24), Group III (claims 25-32), and Group IV (claim 33), and restriction was made to one of them under 35 U.S.C. § 121. Applicants elect group I with traverse, because the restriction requirement is not proper.

The present application is a PCT application in U.S. national stage (filed under 35 U.S.C. § 371). MPEP 1893.03(d) specifically reminds examiners that PCT unity of invention practice, rather than U.S. restriction practice, is applicable in international applications in national stage (See also 37 CFR 1.499, MPEP 801). It appears that the Examiner applied the restriction practice.

Under the rules regarding unity of invention practice, the present U.S. stage application does not lack unity of invention, and should thereby not be restricted. The examiner failed to establish that Groups I, II, and IV lack unity of invention. Groups I, II, and IV exhibit corresponding special technical features (37 CFR 1.475 (a)): Group II is drawn to a protein; Group I is drawn to DNA molecules encoding the protein; and Group IV is drawn to an antibody to the protein. Specifically, there is unity of invention between Groups I and II, according to Administrative Instructions under the PCT (See Annex B to MPEP, Example 17). Similarly, there is also unity of invention between Groups I and II, because the antibody claimed in Group IV is raised with the protein (or a portion of it) claimed in Group II, and used mainly to bind the protein (or a portion of it).

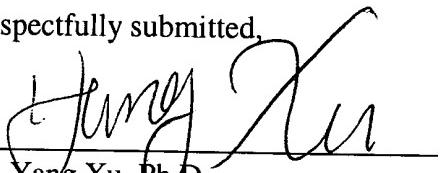
The examiner failed to establish that Groups II, and III lacks unity of invention. Group III is drawn to a method of identifying a substance that modulates the protein, i.e., a process of using the product claimed in group II. Thus, there is unity of invention between Groups II and III, according to 37 CFR 1.475 (b)(2).

Accordingly, the Applicants respectfully request that the examiner reconsider the decision and withdraw the restriction requirement.

Allowance of claims 1-33 is earnestly solicited.

Respectfully submitted,

By



Yang Xu, Ph.D.

Reg. No. 45,243
Attorney for Applicant
MERCK & CO., INC.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-1307
(732) 594-4720 (Fax)

Date: November 6, 2002